

REMARKS

Status of the Claims

Claims 17-27 are pending in this application. Claims 28 and 29 are cancelled.

Interview Summary

In the Interview Summary, the Examiner writes,

The applicants will present a case law to rebut the rejection under 35 USC 112, first paragraph. Discuss the difference between the color photothermographic and monochromatic photothermographic material, and the results presented in the Declaration under 37 CFR 1.132 on October 6, 2003.

The rejection of claims 17-29 under 35 U.S.C. § 112, first paragraph, for allegedly containing subject matter not described in the specification was discussed. Applicants' Representative explained to the Examiner that his rejection was contrary to the established case law. (However, this issue is moot in view of the amendments to the claims).

The rejection of claims 17-22 and 25-29 under 35 U.S.C. § 103(a) for allegedly being unpatentable over either Takeuchi or Nakamura in view of the combination of Cerquone and EP '196, and the rejection of claims 23-24 under 35 U.S.C. § 103(a) for allegedly being unpatentable over Takeuchi or Nakamura, and further

in view of JP '934 were discussed. Applicants' comments during the interview have been incorporated into the remarks hereinbelow.

Rejection of Claims 17-29 Under 35 U.S.C. 112, First Paragraph

Claims 17-29 are rejected by the Examiner under 35 U.S.C. 112, first paragraph, for the reasons set forth in paragraph 2 of the office action. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

This rejection is moot in view of the cancellation of the language objected to by the Examiner. This is clearly a non-narrowing claim amendment as the amended language corresponds to the language found in claim 9, except that formula (3) is deleted. Thus, the rejection should be withdrawn.

Rejection of Claims 17-22 and 25-29 Under 35 U.S.C. 103(a)

Claims 17-22 and 25-29 have been rejected by the Examiner under 35 U.S.C. § 103(a) for allegedly being unpatentable over either Takeuchi or Nakamura in view of the combination of Cerquone and EP '1961. Claims 23-24 have also been rejected by the Examiner under 35 U.S.C. § 103(a) for allegedly being unpatentable over Takeuchi or Nakamura, and further in view of JP '934. These

rejections are respectfully traversed. Reconsideration and withdrawal thereof are requested.

During the interview, Applicants' Representative emphasized the difference between "monochromatic photothermographic material" of the present invention and "color photosensitive material" of the prior art. Indeed, the dictionary definition of "monochromatic" was provided to the Examiner. Applicants' Representative further argued that "color photosensitive material" means two or more colors, whereas "monochromatic photothermographic material" means one color only.

In response, the Examiner maintained his argument that there was essentially no difference between monochromatic and color photosensitive materials. In particular, the Examiner argued that the skilled artisan could pick any one color (for example, from the three colors presented in Table 1, column 80, of Takeuchi), and that one color would be "monochromatic."

Applicants disagree with the Examiner's assertion that the skilled artisan would "pick and choose" any one color from Table 1 of Takeuchi. The Examiner cannot use hindsight to "pick and choose" any one color from a variety of colors. Indeed, modifying the teachings of the prior art in the manner suggested by the Examiner would destroy the teachings thereof or change the

principle of operation of the reference. See In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984); In re Ratti, 123 USPQ 349 (CCPA 1959); MPEP 2143.01.

In order to further distinguish the present invention from the cited prior art, Applicants have amended claim 17 to include the following phrase: "and free from a dye-forming coupler." Thus, the claimed invention excludes the presence of a dye-forming coupler. Indeed, the specification of the present application does not utilize a dye-forming coupler. Further, none of the working examples described in the specification utilize a dye-forming coupler. Also, claim 15 recites that the images are formed from silver rather than with dye-forming couplers. Thus, one of ordinary skill in the art would readily understand that the present specification discloses a monochromatic photothermographic material free from a dye-forming coupler. Clearly, the Examiner's position is without basis as the cited prior art does not disclose a monochromatic photothermographic material free from a dye-forming coupler.

The silver halide photographic light-sensitive material of Takeuchi '745 comprises a dye-forming coupler as an essential component. Please see claim 1 of Takeuchi '745. This is entirely contrary to the present invention.

The silver halide photographic light-sensitive material of Nakamura '421 also comprises a dye-forming coupler as an essential component. Please see the abstract and column 40 of Nakamura '421. Takeuchi '745 and Nakamura '421 are thus irrelevant to the claimed invention. Indeed, the cited prior art teaches away from the present invention.

Applicants respectfully submit that the Examiner cannot maintain his argument that there is essentially no difference between monochromatic and color photosensitive materials. The Examiner cannot use hindsight to "pick and choose" any one color from a variety of colors.

Cerquone '240 merely discloses 2,6-dichloro or 2,6-dibromo-4-sulfonamido-phenol as a reducing agent. Cerquone '240 is silent of bisphenol compounds. Please see the abstract and Claims 1 and 2 of Cerquone '240.

Accordingly, the Examiner has not set forth a prima facie case of obviousness.

During the interview, Applicants' Representative discussed Mr. Oya's Declaration filed on October 6, 2003. The Examiner emphasized two points with regard to the Declaration. First, the Examiner asserted that only the attorney arguments, rather than the actual Declaration, state that the results obtained are unexpected. The

Examiner pointed out that the Declaration states that the range of 0.1 mole % to 10 mole % is critical, but is silent as to whether the results obtained from using this range are unexpected. Second, the Examiner asserted that the results obtained and shown on page 5 of the Declaration are not significant.

With regard to the data disclosed in Mr. Oya's declaration filed on October 6, 2003, the Examiner's attention is directed to the first paragraph on page 6 thereof. Mr. Oya explicitly states that Sample No. 704 having a (D-119)/(D-1) ratio of more than 10% is not practical due to the strong fog whereas Samples Nos. 702 and 703 having a (D-119)/(D-1) ratio of the claimed range showed improvement of sensitivity and low fog. Mr. Oya further states that this result indicates that the range of 0.1 mole % to 10 mole % is critical in the claimed invention and the criticality is not predictable from the cited references.

Accordingly, the Examiner's first and second assertions outlined above are contrary to the factual evidence of record and unsupported. If the Examiner does not believe the data, then the Examiner should clarify his position in this regard. Mr. Oya clearly indicates that the difference is significant and the results are unexpected. The Examiner is thus obligated to consider this factual evidence.

The Examiner should further note that Takeuchi '745 and Nakamura '421 state that the preferable ratio is 20 mole % to 500 mole %. One of ordinary skill in the art would not have been motivated to use a ratio of 0.1 mole % to 10 mole %. One of ordinary skill in the art could not have predicted that the claimed range shows unexpected improvement with respect to sensitivity and low fog. Further, the range suggested by Takeuchi '745 and Nakamura '421 show poor results.

Finally, during the interview Applicants' Representative argued that the phenol compounds as utilized in the present invention function differently from the phenol compounds in Cerquone. Specifically, Applicants' Representative argued that the phenol compounds of the present invention work as a reducing agent for silver salt, whereas the phenol compounds of Cerquone react with silver halide to form a dye. The Examiner agreed that the phenol compounds of Cerquone do not perform the same function as those of the present invention. However, the Examiner pointed to the last paragraph in column 67 of Takeuchi as evidence that the phenol compounds could be used for both functions. Clearly, the Examiner is once again "picking and choosing" from the teachings of the prior art in order to obtain the present invention. The Examiner is clearly using impermissible hindsight in an attempt to

suggest the present invention. A modification unwarranted by the disclosure of a reference is improper. Carl Schenck, A.G. v. Norton Corp., 218 USPQ 698 (Fed. Cir. 1983)

In summary, the Examiner has failed to establish a prima facie case of obviousness. Assuming, arguendo, the Examiner has established a prima facie case of obviousness (a point not conceded by Applicants), the Examiner should note that the Declaration evidence of record clearly rebuts any prima facie case of obviousness. Thus, the prior art rejections should be withdrawn by the Examiner.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

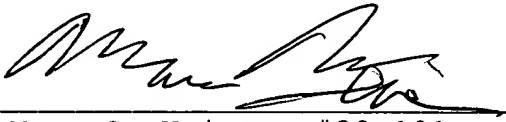
Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of three (3) months to July 7, 2004, in which to file a reply to the Office Action. The required fee of \$950.00 is enclosed herewith.

Appl. No. 09/809,178
Attorney Docket Number 2870-0164P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Marc S. Weiner, #32,181

MSW:gmh
2870-0164P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000